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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/600,917	06/20/2003	Frank Liebenow	P1945US00	6906
24333	7590	05/05/2006	EXAMINER	
GATEWAY, INC. ATTN: Patent Attorney 610 GATEWAY DRIVE MAIL DROP Y-04 N. SIOUX CITY, SD 57049			AIRAPETIAN, MILA	
			ART UNIT	PAPER NUMBER
			3625	
DATE MAILED: 05/05/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/600,917	LIEBENOW, FRANK	
	Examiner Mila Airapetian	Art Unit 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 20 June 2003.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-31 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 20 June 2003 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date. _____ .  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>06/20/2003</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____ .                                  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent Claim 1 recites the following limitation: "downloading a content file in a first data format from a remote server to a first user device for a *first cost basis*", which indicates providing services in exchange of receiving a monetary amount. However, dependent claim 2 recites: "said method wherein the *first cost basis is free*", which indicates that there is no "cost" or "paying" at all, which is confusing. Same reasoning applied to the remaining claims.

Independent claim 20 recites a system including "*a logic configured...*", which is confusing. It is not clear to what extend the term "logic" constitutes a structural element.

Regarding claim 7 the phrase "such" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Regarding claim 10, the claim is confusing because it refers to claim 8 while recites the limitation of claim 10 (second payment).

Regarding claim 17, the claim is confusing because it refers to claim 8 while recites the limitation of claim 10 (first payment).

Regarding claim 29, the claim is confusing because it refers to claim 20 while recites the limitation of claim 22 (first payment).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-6 and 8-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Warnock et al. (hereinafter Warnock) (WO 01/29732) in view of Kobata et al. (hereinafter Kobata) (US 2002/0082997).**

**Claim 1.** Warnock teaches a method for providing information over a public data network with access control and paid transaction comprising:

downloading a content file in a first data format from a remote server to a first user device for a first cost basis (Abstract; page 4, lines 19-26);

granting a capability to use said content file by paying a second cost basis (page 4, lines 22-26).

However, Warnock does not specifically teach that said granting a capability to use said content file by paying a second cost basis includes converting said first format into the second (usable) format.

Kobata teaches controlling and managing digital assets wherein the authorized users can transform (convert) downloaded multimedia files from one format to another for viewing or copying of said multimedia files [0095], [0175].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Warnock to include converting said first format into the

second (usable) format, as disclosed in Kobata, because it would advantageously allow the customer to download any type of digital files to the customer's system regardless of the formats of said digital files, thereby providing convenience to the user.

**Claim 2.** Warnock teaches said method wherein the first cost basis is free (page 4, lines 23-25).

**Claim 3.** Kobata teaches said method wherein the first data format of the content file is different than the data format of the second data format [0095]. The motivation to combine Warnock and Kobata would be downloading any type of digital files to the customer's system regardless of the formats of said digital files.

**Claim 4.** Kobata teaches said method wherein the second data format is selected from the group consisting of an audio wave and an MP3 [0096]. The motivation to combine Warnock and Kobata would be downloading any type of digital files to the customer's system regardless of the formats of said digital files.

**Claim 5.** Kobata teaches said method wherein the first data format of the content file is not suitable for playback on a device selected from the group consisting of an audio CD player and an MP3 player ([0095], transforming different formats into *usable* formats indicates that those formats would not be suitable for playback on a device). The motivation to combine Warnock and Kobata would be downloading any type of digital files to the customer's system regardless of the formats of said digital files. As per "MP3" feature *per se*, see reasoning applied to claim 4.

**Claim 6.** Kobata teaches said method wherein the second data format of the content file is encoded for playback on a player equipped to decode the content file [0181]. The motivation to combine Warnock and Kobata would be to secure the digital asset during transmission and make efficient user of resources (e.g., network, bandwidth, storage, or memory).

**Claim 8.** Warnock teaches a system for providing information over a public data network with access control and paid transaction comprising:

means for storing encoded content in a first protected format (downloading a content file in a first data format from a remote server indicates means for storing said content in said first format (Abstract; page 4, lines 19-26);

means for decoding the encoded content for playback directly on the audio playback subsystem (page 4, lines 22-26);

means for conducting a payment transaction with a means for receiving payment (Abstract; page 4, lines 22-26).

However, Warnock does not specifically teach means for converting the encoded content into a second format.

Kobata teaches a system for controlling and managing digital assets including means for transforming (converting) downloaded multimedia files from one format to another for viewing or copying of said multimedia files [0095], [0175].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Warnock to include means for converting said first format into the second (usable) format, as disclosed in Kobata, because it would advantageously allow the customer to download any type of digital files to the customer's system regardless of the formats of said digital files, thereby providing convenience to the user.

**Claim 9.** Warnock teaches said system wherein the second format comprises an unprotected format suitable for playback (Abstract; page 4, lines 19-26).

**Claim 10.** Warnock teaches said system wherein the means for conducting a payment transaction further comprises means for conducting first and second payment transactions, the first payment transaction enabling the means for decoding to decode the encoded content for playback directly on the system's audio playback system (Abstract; page 8, line 29 – page 9, line 9).

**Claim 11.** Warnock teaches that second payment transaction enables converting the encoded content to be used for playback (Abstract; page 4, lines 19-26). As per "format" feature per se, see reasoning applied to claim 8.

**Claim 12.** Warnock teaches said system further comprising a means for receiving payment in communication with the means for conducting a payment transaction (Abstract; page 4, lines 19-26).

**Claim 13.** Warnock teaches said system further comprising a content source in communication with the means for storing encoded content (receiving content files at the system's computer indicates receiving said files from a source) (Abstract; page 4, lines 19-26).

**Claim 14.** The necessity to convert the digital file from first format to usable format in Kobata indicates that the first protected format is not suitable for playback directly on the system's audio playback subsystem [0181].

**Claim 15.** The necessity to convert the digital file from first format to usable format in Kobata indicates that the first protected format is not suitable for playback directly on the system's audio playback subsystem, wherein said playback is conducted on an audio CD player or on an MP3 player [0181].

**Claim 16.** Warnock teaches said system wherein the system comprises a PC (Fig. 8).

**Claim 17.** Warnock teaches that the first payment transaction is free (Abstract).

**Claim 18.** Kobata teaches said system wherein the second format is encoded with a unique identifier such that the second format is suitable for playback only on devices which are equipped with the unique identifier [0181]. The motivation to combine references is to provide security to the system.

**Claim 19.** Kobata teaches said system wherein the unique identifier is selected from the group consisting of a cryptographic key and a serial number [0181]. The motivation to combine references is to provide security to the system.

**Claim 20.** Warnock teaches a system for providing information over a public data network with access control and paid transaction comprising:

a memory configured to store encoded content (Abstract, page 4, lines 19-26),

said memory including computer-readable instructions for conducting the following steps:

decoding the encoded content for playback directly on the audio playback subsystem (page 4, lines 22-26);

conducting a payment transaction with a payment receiver (Abstract, page 4, line 22-26);

However, Warnock does not specifically teach converting the encoded content into a second format.

Kobata teaches a system for controlling and managing digital assets including means for transforming (converting) downloaded multimedia files from one format to another for viewing or copying of said multimedia files [0095], [0175].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Warnock to include converting said first format into the second (usable) format, as disclosed in Kobata, because it would advantageously allow the customer to download any type of digital files to the customer's system regardless of the formats of said digital files, thereby providing convenience to the user.

**Claim 21.** Warnock teaches said system wherein the second format comprises an unprotected format suitable for playback (Abstract; page 4, lines 19-26).

**Claim 22.** Warnock teaches said system wherein the means for conducting a payment transaction further comprises means for conducting first and second payment transactions, the first payment transaction enabling the means for decoding to decode the encoded content for playback directly on the system's audio playback system (Abstract; page 8, line 29 – page 9, line 9).

**Claim 23.** Warnock teaches that second payment transaction enables converting the encoded content to be used for playback (Abstract; page 4, lines 19-26). As per "format" feature per se, see reasoning applied to claim 8.

**Claim 24.** See reasoning applied to claim 20.

**Claim 25.** Warnock teaches said system further comprising a content source in communication with the means for storing encoded content (receiving content files at the system's computer indicates receiving said files from a source) (Abstract; page 4, lines 19-26).

**Claim 26.** The necessity to convert the digital file from first format to usable format in Kobata indicates that the first protected format is not suitable for playback directly on the system's audio playback subsystem [0181].

**Claim 27.** The necessity to convert the digital file from first format to usable format in Kobata indicates that the first protected format is not suitable for playback directly on the system's audio playback subsystem, wherein said playback is conducted on an audio CD player or on an MP3 player [0181].

**Claim 28.** Warnock teaches said system wherein the system comprises a PC (Fig. 8).

**Claim 29.** Warnock teaches that the first payment transaction is free (Abstract).

**Claim 30.** Kobata teaches said system wherein the second format is encoded with a unique identifier such that the second format is suitable for playback only on

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devices which are equipped with the unique identifier [0181]. The motivation to combine references is to provide security to the system.

**Claim 31.** Kobata teaches said system wherein the unique identifier is selected from the group consisting of a cryptographic key and a serial number [0181]. The motivation to combine references is to provide security to the system.

**Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Warnock and Kobata, as applied to claim 1, and further in view of Cponce (US 20030156719).**

**Claim 7.** The combination of Warnock and Kobata teaches all the limitations of claim 7 except that wherein the second data format of the content file is encoded such that it is suitable for playback on only one audio player.

Cponce teaches a method for delivery of a licensed toolset to a software publisher for creating license-managed software products wherein the software product can run only on a specific machine [0040].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Warnock and Kobata to include that the data format of the content file is encoded such that it is suitable for playback on only one machine, as disclosed in Cponce, because it would allow to control use of software for the purpose of limiting or eliminating unauthorized use of software ([0003], Cponce).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(i) US 2002/0073220 to Lee discloses method of transmitting multimedia contents from the internet to client systems.

(ii) US 6,385,596 to Wiser discloses secure online music distribution system.

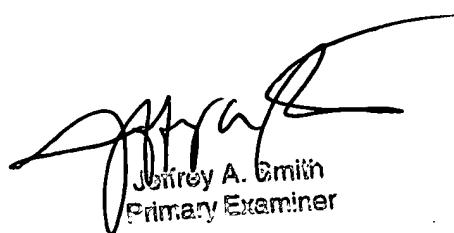
(iii) US 2005/0033864 to Matsushima discloses digital data distribution system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mila Airapetian whose telephone number is (571) 272-3202. The examiner can normally be reached on Monday-Friday 9:30 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Smith can be reached on (571) 272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MA



Jeffrey A. Smith  
Primary Examiner